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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,433	04/20/2001	Claude Jarkae Jensen	10209.56	1737

21999 7590 10/02/2002

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EXAMINER	
GOLLAMUDI, SHARMILA S	
ART UNIT	PAPER NUMBER
1616	

DATE MAILED: 10/02/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/839,433	Applicant(s) JENSEN ET AL.	
	Examiner Sharmila S. Gollamudi	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *19 July 2002* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,6-8,11,12,22 and 27* is/are pending in the application.

4a) Of the above claim(s) *28-30* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,6-8,11,12,22 and 27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Amendment A filed on July 19, 2002 is acknowledged. Claims 1, 6-8, 11-12, 22, and 27 are included in the prosecution of this application. Claims 2-5, 9-10, 13-21, and 23-26 are cancelled.

Newly submitted claims 28-30 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: new claims recite a method of manufacturing the lip treatment is related to the original claims as process of making and product made. The inventions are distinct if Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the composition may be made in a different process and doesn't require the instant method. Also, the process can make a materially different compositon.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 28-30 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Response to Arguments

Rejection of claim 1 under 35 U.S.C. 102(e) as being anticipated by Wadsworth et al (6214351) is withdrawn.

Rejection of claims 1-18, 20, and 22- 27 under 35 U.S.C. 103(a) as being unpatentable over Lane (5503825) in combination with Wadsworth et al (6214351) is withdrawn.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Rejection of claims 1, 6-8, 11-12, 22, and 27 under 35 U.S.C. 103(a) as being unpatentable over Krog et al (5945092) in combination with Wadsworth et al (6214351) is maintained.

Response to Arguments

Applicant argues that Krog et al teach an anhydrous cosmetic stick composition with transfer resistance and contains volatile solvents and polymeric organosiloxane emulsifiers. Applicant argues that instant invention provides for a lip treatment, which provides significant help in lip care over the references cited.

Applicant's arguments have been fully considered but they are not persuasive. In response to applicant's arguments, the recitation lip treatment has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural

limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Therefore, the preamble does not make the composition materially different from Krog et al; both are topical cosmetic compositions. In regards to the argument that Krog contains other components that are not found in the instant composition, the examiner points out that the instant claim language does not exclude other components such as solvents and polymers. Krog et al teaches the use of an essential oil from 1-20% in the cosmetic composition and Wadsworth teaches the instant essential oil has fatty acids known in the art for their conditioning properties.

New Rejections in Light of Amendments

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wadsworth et al (WO 01/15537) or in view of Moniz (5288491).

Wadsworth et al teaches morinda citrifolia oil, which can be used in cosmetics (col. 3, line 42). Further, Wadsworth teaches the instant extract contains linoleic fatty acid (page, 2, lines 1-2 and claim 15)

Wadsworth et al do not teach xeronine or the use of the juice.

Moniz teaches xeronine occurs in all healthy cells of plants and the noni fruits contain appreciable amounts of the precursor of xeronine (col. 3, lines 5-18). Further, Moniz teaches the use of the plant extract for sores, cuts, and boils and the application of the oil to the hair.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Wadsworth et al and Moniz since Moniz teaches that the Noni plant and its extracts contain xeronine. Further, in the absence of showing unexpected results, it is within the skill of a practitioner to determine particular ranges as part of the process of normal optimization.

Claims 1, 6-8, 11-12, 22, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pillai et al (6261566) in view of Wadsworth et al (WO 01/15537), in further view of Moniz (5288491).

Pillai et al teach a cosmetic composition containing a mulberry extract in the range of .001 to 20% in a cosmetically acceptable vehicle (col. 2, lines 32-37). The vehicle can be from 5 to 99.9%. Pillai teaches an emulsion containing .5 to 50% of fatty acids or alcohols (cetyl) or hydrocarbons such as petroleum jelly, squalene, or isoparaffins (col. 3, lines 58-61). The composition can contain the Benezophenone-3 or other sunscreen (col. 3, lines19-30). The reference teaches the topical use of the composition for conditioning, moisturizing, and smoothening of the skin (col. 4, lines 20-25).

Pillai does not specify the mulberry extract is morinda citrifolia oil. Further, Pillai does not teach linoleic acid or xeronine in the extract.

Wadsworth et al teaches morinda citrifolia oil, which can be used in cosmetics (col. 3, line 42). Further, Wadsworth teaches the instant extract contains linoleic fatty acid (page, 2, lines 1-2 and claim 15)

Moniz teaches xeronine occurs in all healthy cells of plants and the noni fruits contain appreciable amounts of the precursor of xeronine, which is used for herbal remedies (col. 3, lines 5-18). Further, Moniz teaches the use of the plant extract for sores, cuts, and boils and the application of the oil to the hair.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use morinda citrifolia oil in Pillai's cosmetic composition with the expectation of similar results since Pillai teaches a generic mulberry extract composition. Further motivation to use morinda citrifolia is that Wadsworth teaches the instant oil contains essential fatty acids, known for their conditioning properties and Moniz teaches the use of the instant plant extracts for its wound healing properties.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharmila S. Gollamudi whose telephone number is 703-305-2147. The examiner can normally be reached on M-F (7:30-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees can be reached on 703-308-4628. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 709-3080196.

SSG
September 30, 2002

JOSE G. DEES
SUPERVISORY PATENT EXAMINER
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